

REMARKS

Applicants are amending their claims in order to further clarify the definition of various aspects of the present invention. Specifically, Applicants have amended claim 17 in light of comments by the Examiner in Item 1 on page 2 of the Office Action mailed December 10, 2007. Moreover, Applicants have amended claims 51, 53, 61, 63, 71 and 73 in light of comments by the Examiner in Item 2 on page 3 of the Office Action mailed December 10, 2007. Note that in claims 51, 61 and 71, Applicants have substituted "may be" with --is--, in light of the singular noun "each".

Moreover, Applicants are adding new claims 85 and 86 to the application. Claim 85, dependent on claim 10, recites that the cyanate ester compound and/or a prepolymer thereof has been reacted with the monovalent phenol compound in the presence of the polyphenylene ether resin to obtain to a phenol-modified cyanate ester oligomer in the resin composition. In connection with claim 85, note, for example, claim 43.

Independent claim 86 recites a resin composition for printed wiring board, selected from first and second compositions, the first composition being that set forth in claim 10, and the second composition being that set forth in claim 43.

It is respectfully submitted that each of claims 85 and 86 reads on the elected invention and elected specie, and it is respectfully requested that, in addition to other claims being considered on the merits, claims 85 and 86 be considered on the merits in the above-identified application.

Noting the contention by the Examiner in each of Items 1 and 2 on pages 2 and 3 of the Office Action mailed December 10, 2007, that "[m]ore favorable consideration" would be given where amendments to claims 17, 51, 53, 61, 63, 71 and 73 were made, as these amendments have been made it is respectfully requested that such "more favorable consideration" be given.

Applicants respectfully submit that all of the claims being considered on the merits in the above-identified application patentably distinguish over the teachings of the documents as applied by the Examiner in rejecting claims in the Office Action mailed December 10, 2007, that is, the teachings of the U.S. patent publications to Takai, et al., Patent Application Publication No. 2005/0121229, to Mizuno, et al., Patent No. 7,157,506, to Davis, et al., Patent No. 7,022,777, to Sugio, et al., Patent No. 4,496,695, and to Sase, et al., Patent No. 6,156,831, Japanese Patent Document No. 2000-336188, Japanese Patent Document No. 2001-240723, and Japanese Patent Document No. 2002-309085, under the provisions of 35 USC 102 and 35 USC 103.

Initially, the dates, for prior art purposes, of Takai, et al. and of Japanese Patent Document No. 2002-309085 (that is, June 9, 2005 and October 23, 2002), are noted. Each of the dates, for prior art purposes, of Takai, et al. and of No. 2002-309085 is after the date being relied upon under 35 USC 119 for the above-identified application (that is, the filing dates of Japanese Patent Application No. 2002-286878 and No. 2002-287071, each filed September 30, 2002).

Certified copies of the priority documents have been received in the U.S. Patent and Trademark Office, and an acknowledgement has been made of a claim for foreign priority based thereon, set forth in the Office Action Summary of the Office Action mailed October 11, 2007, in the above-identified application.

Moreover, for satisfying requirements of 35 USC 119 and 37 CFR 1.55, enclosed please find English translations of Japanese Patent Application No. 2002-287071 and No. 2002-286878. Note especially the English translation of No. 2002-287071, and in particular the disclosure therein, e.g., in paragraph [0016] on page 13. Note also paragraph [0049] on page 22; paragraphs [0018]-[0023] on pages 13 and 14; paragraphs [0053] and [0054] on pages 23 and 24;

paragraph [0057] on page 24; and paragraph [0012] on page 12, of the enclosed English translation of No. 2002-287071.

In view of the present submission of the enclosed English translations of the Japanese priority applications for the above-identified application, particularly the enclosed translation of No. 2002-287071, it is respectfully submitted that Applicants are to be accorded benefit of the filing date of the Japanese priority applications, i.e., September 30, 2002. As September 30, 2002 is prior to the dates, for prior art purposes, of Takai, et al. and Japanese Patent Document No. 2002-309085, reconsideration and withdrawal of Takai, et al. and of No. 2002-309085 as prior art in connection with the presently claimed subject matter are respectfully requested.

Moreover, turning to the prior art rejections on pages 4-8 of the Office Action mailed December 10, 2007, the following is noted.

Thus, all claims being considered on the merits have been rejected under 35 USC 103(a) as unpatentable over Mizuno, et al. in view of Japanese Patent Document No. 2002-309085. As No. 2002-309085 does not constitute prior art, it is respectfully submitted that this rejection on page 4 of the Office Action mailed December 10, 2007, must fall on this basis alone.

Moreover, the Examiner has rejected all of the presently pending claims being considered on the merits, over the combined teachings of Takai, et al., Sugio, et al., Davis, et al. and No. 2002-309085. Thus, all four (4) documents have been used in the rejection. As Takai, et al. and No. 2002-309085 are not prior art in connection with the presently claimed subject matter, this rejection over the combined teachings of the four (4) references must fall on this basis alone.

In addition, all of the claims being considered on the merits in the above-identified application have been rejected over the combined teachings of Japanese Patent Document No. 2000-336188, Sase, et al. and No. 2002-309085. All three (3)

of the patent documents have been applied in a single rejection. As No. 2002-309085 does not constitute prior art, it is respectfully submitted that this rejection as set forth on page 7 of the Office Action mailed December 10, 2007, must fall on this basis alone.

Furthermore, all of the claims presently being considered on the merits in the above-identified application have been rejected over the combined teachings of Japanese Patent Document No. 2001-240723, Sase, et al. and No. 2002-309085. All three (3) documents have been applied in this single rejection. As No. 2002-309085 does not qualify as prior art in connection with the presently claimed subject matter, this rejection as set forth on page 8 of the Office Action mailed December 10, 2007, must fall on this basis alone.

As can be seen in the foregoing, all of the rejections under 35 USC 103 set forth in the Office Action mailed December 10, 2007, must fall, on the basis that Takai, et al., and especially Japanese Patent Document No. 2002-309085, do not qualify as prior art in connection with the presently claimed subject matter. Accordingly, reconsideration and withdrawal of the prior art rejections are respectfully requested.

As additional issues, note that Mizuno, et al., as well as the corresponding published application thereof, would be disqualified as prior art under 35 USC 103, being commonly owned with the above-identified application and being published subsequent to the filing date under 35 USC 119 for the above-identified application. However, note the corresponding PCT publication to Mizuno, et al. having a publication date of September 27, 2001. If subject matter of Mizuno, et al. is maintained in a rejection, it is respectfully requested that the Examiner reconsider and clarify the reference being applied.

From the foregoing, and for purposes of conciseness, it can be seen that the substance of the prior art rejections has not been addressed, in that clearly the rejections must fall based upon the dates, for prior art purposes, of the applied documents, and the benefit date to be accorded the above-identified application. Such lack of addressing the substance of the rejections is for conciseness, and does not constitute agreement with, or an admission as to the propriety of, contentions made by the Examiner in connection with these rejections.

In view of the foregoing comments and amendments, reconsideration and allowance of all claims being considered on the merits in the above-identified application, including newly submitted claims 85 and 86, are respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 511.44961X00), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

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